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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,132	01/12/2001	Jeffrey B. Hoke	4590/4591A(CIP)	8892

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EXAMINER

VANOY, TIMOTHY C

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 08/02/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09-758,132

Applicant(s)

HOKE et al.

Examiner

VANOY

Group Art Unit

1754

mk-12

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on MAILED JULY 12, 2002 AND MAY 29 2001

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The person having "ordinary skill in the art" has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this application reasonably reflect this level of skill.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The Applicants are advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for

the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 are rejected under 35 USC 103(a) as being unpatentable over the English translation DE 40 07 965 A1 in view of U. S. Pat. 4,673,594.

The English translation of DE-965 describes what appears to be at least an obvious variation of the same automobile radiator (i. e. the "substrate" of Applicants' claims 1, 3 and 8) coated with a mixture of copper oxides and manganese oxides catalyst particles (i. e. the Applicants' "catalyst" of Applicants' claims 1, 2 and 6) by using a "heat resistant binder" (i. e. corresponding to the "second material" of Applicants' claim 1) to adhere this mixture of copper oxide and manganese oxide particles onto the surface of the radiator. Please see pgs. 2 and 3 and claims 1 and 2 in the English translation of DE-965.

The difference between the Applicants' claims and DE-965 is that Applicants' claim 1 sets forth that the "second material" may be a clay, whereas pg. 2 4<sup>th</sup> full paragraph in the English translation of DE-965 fairly suggests that a "heat-resistant binder" was used to adhere the catalyst to the surface of the radiator but does not identify what this "heat-resistant binder" is.

U. S. Pat. 4,673,594 is drawn to the same art of adhering compositions onto surfaces by spraying a mixture containing the composition and a binder onto the surface (please compare Fig. 1 illustrated in U. S. Pat.-594 to Fig. A illustrated in the DE-965 and also note the disclosure set forth in the "Field of the Invention" in col. 1 in U. S. Pat.-594). While the process of U. S. Pat.-594 uses an aluminum phosphate liquid as the binder (please see claim 1 in U. S. Pat.-594), the comment set forth in col. 2 lns. 55-57: "A

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temperature resistant clay is added to the binder to produce the tacky characteristic.

Preferably, the clay is a montmorillonite clay. . . " fairly suggests to one skilled in this art that clay, especially montmorillonite clay, either *is* or *may be used as* the "heat-resistant binder" mentioned on pg. 2 4<sup>th</sup> full paragraph in the English translation of DE-965.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made *to utilize* the clay mentioned in col. 2 lns. 55-57 in U. S. Pat.-594 as *the* "heat-resistant binder" mentioned on pg. 2 4<sup>th</sup> full paragraph in the English translation of DE-965, in the manner to arrive at the invention of (at least) Applicants' claims 1, 4 and 5, *because* the courts have already determined that such selection of a known material (in this case, the "clay" mentioned in col. 2 lns. 55-57 in U. S. Pat.-594 and in (at least) Applicants' claims 1, 4 and 5) based on its suitability for its intended use (in this case, its use would be the "heat-resistant binder" set forth on pg. 2 4<sup>th</sup> full paragraph in the English translation of DE-965 - as suggested in col. 2 lns. 55-57 in U. S. Pat.-594) supports a *prima facie* obviousness determination: please see the discussion of the *Sinclair & Carroll Co. vs. Interchemical Corp.* 325 U. S. 327, 65 USPQ 297 (1945) court decision set forth in section 2144.07 in the MPEP (8<sup>th</sup> ed.) for further details. Note that the "temperature resistant" descriptor of clay set forth in col. 2 ln. 56 in US-594 is submitted to meet the "heat-resistant" criteria for the binder set forth on pg. 2 4<sup>th</sup> full paragraph in DE-965.

The difference between the Applicants' claims and DE-965 and US-594 is that Applicants' claim 7 calls for the use of *attapulgate* clay, whereas "clay" is generically referred to col. 2 ln. 56 in US-594, *however* it is submitted that this difference would have

been obvious to one of ordinary skill in the art at the time the invention was made *because* the broad disclosure of the genus of "clays" mentioned in col. 2 Ins. 56 in US-594 is submitted to fairly suggest the utility of *all* clays - including the particular attapulgate species mentioned in Applicants' claim 7.

### ***Response to Arguments***

The Applicants' arguments submitted in their Response mailed on July 12, 2002 (paper no. 11) have been considered, but are not moot in view of the new grounds of rejection.

The following references from the Applicants' Search Report for PCT/US01/01260 submitted with the IDS mailed on May 29, 2001 (paper no. 4) are made of record: U. S. Pat. 6,200,542 B1; U. S. Pat. 5,997,831; U. S. Pat. 5,856,263; U. S. Pat. 5,382,416; EP 0 893 156 A2; U. S. Pat. 5,140,949 and U. S. Pat. 5,203,887.

U. S. Pat. 3,876,384 disclosing a heat resistant binder comprising clay in the catalyst art (please see claim 6) is made of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy C. Vanoy whose telephone number is 703-308-2540. The examiner can normally be reached on 8 hr. days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached at 703-308-3837. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Timothy Vanoy/tv

  
Timothy Vanoy

July 29, 2002

Patent Examiner

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